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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/728,395	12/01/2000	Paul Mills	11033-063001/ A9942US-DJL	3395
26161	7590	09/09/2004	EXAMINER	
FISH & RICHARDSON PC 225 FRANKLIN ST BOSTON, MA 02110			PARADISO, JOHN ROGER	
			ART UNIT	PAPER NUMBER
			3721	
DATE MAILED: 09/09/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/728,395

Applicant(s)

MILLS, PAUL

Examiner

John R Paradiso

Art Unit

3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Request for Continued Examination

1. The request filed on 6/1/2004 for a Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/728,395 is acceptable and a CPA has been established. An action on the CPA is attached.

Claim Rejections

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1, 2, and 6 are rejected under 35 U.S.C. § 102(b) as being anticipated by KOMIYA ET AL, as set forth in paragraph 2 of the previous Office Action.
4. Claims 3-5 and 7-13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over KOMIYA ET AL, as set forth in paragraph 3 of the previous Office Action.

Response to Arguments

5. Applicant's affidavit filed 6/1/2004 has been fully considered but is not persuasive.

6. Applicant states in paragraph 7 of his affidavit that "Komiya does not explicitly describe such a system, and there is no reason to assume from what is said in Komiya that the system described in Komiya would have" the claimed features.

However, Applicant does not provide any concrete evidence as to why "there is no reason to assume" that KOMIYA ET AL does not anticipate or make obvious the claimed invention and Examiner maintains that KOMIYA ET AL does anticipated or make obvious the claimed invention for the reasons explained the Final Rejection.

7. Applicant states in paragraph 10 of his affidavit that "I disagree with the Examiner's conclusion. There is no reason to assume that each component has a 'respective connecting means' with a means to translate the data bus commands to commands appropriate to the specific device. Instead, it is more likely to assume Komiya envisaged that if an item of equipment were to be replaced, it would be replaced by an item which operates according to the same protocol .. or else, that the computer controller is reprogrammed .. to cope with such a new item of equipment."

Art Unit: 3721

However, Applicant does not provide any concrete evidence to show why a an item of equipment "would be replaced by an item which operates according to the same protocol .. or else, that the computer controller is reprogrammed .. to cope with such a new item of equipment" but is merely conjecturing how KOMIYA ET AL would have handled Applicant's own concerns. Further, it is irrelevant what KOMIYA ET AL envisaged in handling these issues, but only whether the disclosed invention of KOMIYA ET AL anticipates the claimed invention or would make the claimed invention obvious to one of ordinary skill in the art, all of which is discussed / explained in the Final Rejection.

8. Applicant's arguments filed 6/1/2004 have been fully considered but they are not persuasive.

9. Applicant states on page 2 of his Response under the heading "EXAMINER MUST PROVIDE RATIONALE OR EVIDENCE TENDING TO SHOW INHERENCY" that "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.." and "The office action does not provide nay evidence that establishes that the recited connecting means is necessarily present in Komiya."

Art Unit: 3721

However, as explained in the previous Office Action,

KOMIYA ET AL does not specifically refer to the data bus that transmits signals and translations of commands from the controller to the peripheral units, however, these limitations are inherent in the invention of KOMIYA ET AL: The connecting of a elements of a machine with a controller, such as connecting a printer or floppy drive to a computers CPU or connecting remote sensors and machine control circuits to a PLC, is inherent in structure and is necessary when any components are connected via a data bus to a controller. The same principle applies to a means for translating data bus commands: if this were not so, the above examples of a computer would not be able to communicate with or recognize the printer or floppy drive and the example of a machine with remote sensors and control circuits would not be able to communicate or receive instructions from the PLC.

Put more succinctly, without the recited connecting means, the system wouldn't work.

Therefore, it's inherent there be connecting means. This is true with all machines with a controller and peripherals, from a complex PLC-connected machine with many sensors, to a common desktop PC.

Art Unit: 3721

Conclusion

10. This is an RCE of applicant's earlier Application No. 09/728,395. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

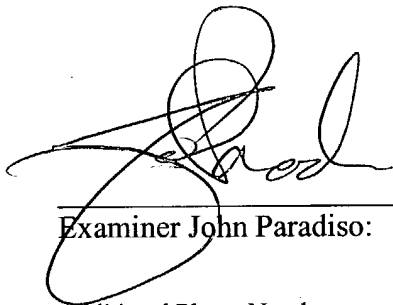
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Art Unit: 3721

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Paradiso. The examiner can normally be reached Monday-Friday, 9:30 p.m. – 6:00 p.m. (ET).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada, can be reached at the number listed below.

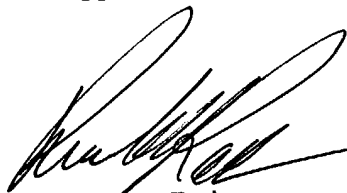
Any inquiry of a general nature or relating to the status of this application should be directed to the 3700 Technology Center Receptionist.



Examiner John Paradiso: (703) 308-2825

Additional Phone Numbers:

Supervisor Rinaldi Rada: (703) 308-2187
TC 3700 Receptionist: (703) 308-1148
Fax (directly to Examiner) (703) 746-3253
Fax (Official): (703) 872-9306


Rinaldi I. Rada
Supervisory Patent Examiner
Group 3700

September 7, 2004